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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,660	05/25/2001	Igor Davidovich Kushnirskiy	0007056-0213/P6298NP/ARG/	4544

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EXAMINER

ZHEN, LI B

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,660

Applicant(s)

KUSHNIRSKIY, IGOR
DAVIDOVICH

Examiner

Li B. Zhen

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,10-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,10-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/10/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 - 3, 5 - 8, 10 - 13 and 15 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 12, 13 and 15 recites the limitation "computer program product of claim 6" in line 1; however, claim 6 recites "a remote inter-language method calling system". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 6 – 8 and 10 – 13 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
7. Claims 6 – 8 and 10 is non-statutory because it is not tangibly embodied in a manner so as to be executable as the only hardware is in an intended use statement. Claim 6 defines "a remote inter-language method calling system" in the preamble and

Art Unit: 2126

the body of the claim recites “a method calling unit”, “a first translator” and “a second translator.” The calling unit and the translators appear to be software modules, which are not tangible. Therefore, claim 6 is non-statutory because it recites a system claim that comprises non-tangible embodiments.

8. Claims 11 – 13 and 15 is non-statutory because it is not tangibly embodied.

Claim 11 recites “a computer program product” [line 1] and the specification discloses computer program product as including carrier waves [p. 15, lines 16 - 18]. Carrier waves are incapable of being touched or perceived absent the tangible medium through which they are conveyed; therefore, claim 11 is non-statutory.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1 - 2, 6 - 7, and 11 - 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent NO. 6,480,901 to Weber.**

11. As claim 1, Webber teaches a method for remote inter-language method calling [a protocol converter for converting communication messages directed from the device

management application program to the managed device from the first communication protocol to the second communication protocol; col. 3, lines 1 – 13] comprising:

issuing a method call using a first protocol [first communication protocol is remote procedure call; col. 3, lines 1 – 15];

translating the method call from the first protocol to an intermediary [UTM format] protocol [RPC conversion agent 522 in server 508 converts the RPC commands to the UTM format before communicating with controller 506; col. 12, lines 1 – 54]; and

translating the method call from the intermediary protocol to a second protocol [UTM-to-internal-messaging component 536 preferably converts the UTM packets to packets and commands which can be understood by management protocol 528; col. 12, lines 1 – 54], wherein the intermediary protocol is *Connect [UTM format].

12. As to claim 2, Weber teaches calling a proxy object [management interface application 830 preferably initiates a proxy object; col. 17, lines 12 – 54].

13. As to claims 6 – 7, these are system claims that correspond to method claims 1 – 2; note the rejections to claims 1 – 2 above, which also meet these system claims.

14. As to claims 11 – 12, these are product claims that correspond to method claims 1 – 2; note the rejections to claims 1 – 2 above, which also meet these product claims.

Claim Rejections - 35 USC § 103

Art Unit: 2126

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 3, 5, 8, 10, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber in view of “A zero generated code XPConnect proposal” [hereinafter Bandhauer, cited in the previous office action].**

17. As to claims 3 and 5, Weber does not specifically identify the first and second protocols.

18. However, Bandhauer teaches XPConnect glue [intermediary protocol] that enables JavaScript code [first protocol] to call across XPCOM [second protocol] interfaces into C++ objects and also C++ code to call across XPCOM interfaces into JavaScript objects [p.1, Introduction].

19. It would have been obvious to a person of ordinary skill in the art at the time of the invention to apply the teaching of providing a XPConnect glue that enables JavaScript code to call across XPCOM interfaces as taught by Bandhauer to the invention of Weber because this permits software reuse by allowing programs that support newer protocols such as XPCOM to communicate with programs that support older protocols such as JavaScript.

20. As to claims 8 and 10, these are system claims that correspond to method claims 3 and 5; note the rejections to claims 3 and 5 above, which also meet these system claims.

21. As to claims 13 and 15, these are product claims that correspond to method claims 3 and 5; note the rejections to claims 3 and 5 above, which also meet these product claims.

Response to Arguments

22. Applicant's arguments filed 9/10/2005 have been fully considered but they are not fully persuasive.

23. Applicant's arguments, see p. 6 – 7 of last response, filed 9/10/2005, with respect to the Mishra reference have been fully considered and are persuasive. The rejections in view of Mishra have been withdrawn.

24. Applicant argues that neither Weber nor Bandhauer teaches Connect as an intermediary protocol [p. 8]. Examiner agrees that neither Weber nor Bandhauer disclose a "*Connect protocol"; however, the UTM protocol of Weber and the XPConnect glue of Bandhauer is separately equivalent to the *Connect intermediary protocol of the current application. Examiner notes that both the UTM protocol and the XPConnect glue act as intermediary protocols [see rejection above]; therefore, the UTM protocol and the XPConnect glue performs the same function as *Connect protocol. Additionally, examiner was unable to locate any explicit definition for the *Connect protocol in the specification. For example, p. 6, line 10 – p. 7, line 18 of the

Art Unit: 2126

specification refers to the *Connect protocol, but does not provide a description or definition for the protocol. Thus, the UTM protocol and the XPConnect glue are not excluded by any explicit definition provided in the specification for an equivalent. The *Connect protocol does not appear to be a well-know protocol in the art. Although applicant is entitled to be his or her own lexicographer, applicant did not provide an explicit definition or description for *Connect protocol that control interpretation of the term as it is used in the claim. The specification merely requires the *Connect protocol to be an intermediary protocol. Therefore, Weber and Bandhauer, alone and in combination, teach the invention as claimed.

Conclusion


25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li B. Zhen whose telephone number is (571) 272-3768. The examiner can normally be reached on Mon - Fri, 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Li B. Zhen
Examiner
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